

**REMARKS**

**I. Status of Claims**

Claims 1-4, 8-20, 22, 25-51, and 57-63 are currently pending. Claims 21, and 23-24 are canceled without prejudice or disclaimer. Claims 1, 16, 22, 30, 59, 62, and 63 are amended herein to recite "wherein said at least one particulate phase B comprises at least one pearlescent agent, present in an amount ranging from 10% to 50% by weight, relative to the total weight of the composition." Support for this amendment can be found in the specification and claims as originally filed, for example, paragraph [059] at pages 16-17 of the specification, as filed, and original claims 21, 23, and 24. Accordingly, no new matter is introduced by this amendment.

**II. Rejections Under 35 U.S.C. § 103(a)**

Claims 1-5, 8-51 and 57-63 remain rejected as allegedly unpatentable under 35 U.S.C. § 103(a) over U.S. Patent No. 6,403,704 to Bara ("the '704 patent"), U.S. Patent No. 6,689,345 to Jager-Lezer ("the '345 patent") or U.S. Patent No. 6,565,862 to Bara ("the '862 patent"). See Final Office Action at pages 7-14. Claims 1-5, 8-51 and 57-63 remain rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over European Patent No. 1 064 930 to Jager-Lezer ("EP '930) or Japanese Patent Application Publication No. 2000-103717 assigned to Mura et al. ("JP '717") in view of EP '930. Applicants respectfully traverse the rejection and submit that the Examiner fails to establish a prima facie case of obviousness for the following reasons.

The '704, '862, and '345 patents

The Examiner argues that, while the '704, '862, and '345 patents do not teach the claimed ratios of organopolysiloxane to particulate phase and binder (see, e.g., claim 1), these patents “teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc. as in claim 58.” Office Action at page 8. The Examiner further contends that these patents “teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance,” and therefore “it would have been obvious for one of ordinary skill in the art at the time of the instant invention to optimizing the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.” *Id.* Applicants respectfully disagree.

Independent claims 1, 59, 62, and 63, as amended, recite “wherein said at least one particulate phase B comprises at least one pearlescent agent, present in an amount ranging from 10% to 50% by weight, relative to the total weight of the composition.” None of the disclosures of the '704, '862, and '345 patents describe the use of a pearlescent agent in the claimed range. While those patents generally disclose, at best, the use of pearlescent agents or nacles in the range from 0 to 20% by weight, and in certain instances a preferred amount in the range from about 2 to 15%, there is no teaching or suggestion in the patents with respect to the desirability of using the higher range from 10% to 50% (see, for example, column 7, lines 34-37 of the '704 patent; column 7, lines 43-45 of the '862 patent; and column 10, lines 8-10 of the '345 patent).

In fact, even though those patents disclose the use of pearlescent agents or nacres in the range from 0 to 20% by weight, the '862 and '345 patents do not use any pearlescent agents in their examples, and the '704 patent only describes the use of 5% brown nacre (Example 3 at column 9), all amounts outside the presently claimed range from 10% to 50%. Thus, the general guidance in each of the three patents provides no reason for a person of ordinary skill to use a larger amount of pearlescent agents in an attempt to arrive at the claimed invention. And the specific guidance provided by the teachings of the examples in these patents leads the person away from the claimed invention. Therefore, the '704, '862, and '345 patents would not have motivated a person of ordinary skill to arrive at the presently claimed range.

As the Examiner has acknowledged, the '704, '862, and '345 patents do not teach the claimed ratios of organopolysiloxane to particulate phase and binder. However, the Examiner argued that one of ordinary skill in the art would have been motivated to "optimize" the compositions of the '704, '862, and '345 patents to achieve the claimed invention. As Applicants have pointed out, those patents do not suggest or provide any guidance regarding the desirability of the claimed ratios. Instead, they teach the amounts of the organopolysiloxane and particulate phases in terms of widely varied percentage.

It is important to note that a prima facie case of obviousness requires a reasonable expectation of success. MPEP 2143.02; *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. MPEP 2143.02; *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). Applicants respectfully submit that there is no reasonable expectation of success for the skilled artisan to go

beyond the range taught in the cited patents and arrive at the claimed range, due to the unpredictability associated with the compositions of components in different amounts.

As shown in the '862 patent, two foundation products having different amounts of organopolysiloxane produced significantly different properties as measured by the amount of composition that was transferred onto a cloth collaret after the foundations were applied to the skin and dried in the air (Example 4, columns 9-10).

Notably, the Declaration under 37 C.F.R. § 1.132 of Marie-Laure DELACOUR ("the Declaration"), submitted with Amendment and Reply to Office Action on December 8, 2008, demonstrates that the compositions had significantly different properties when the amounts of the components were varied. The Declaration describes the preparation and analysis of inventive Compositions 1 and 4, having A/B and C/B ratios within the scope of the claimed invention, and comparative Compositions 2 and 3, having A/B and C/B ratios outside the scope of the claimed invention (see Table 1 of the Declaration). The results indicated that inventive Compositions 1 and 4 "exhibit a pulverulent-to-pasty texture and are sufficiently elastic and deformable such that their shapes can be easily modified, for example, manually, without exudation. Moreover, Compositions 1 and 4 are sufficiently solid and cohesive such that they can retain the cylindrical shape obtained upon extrusion and can be left in the cylindrical shape at ambient temperature and pressure without changing shape, for at least three hours" (pages 4-5 of the Declaration). In contrast, comparative Compositions 2 and 3 are "fragile, crumbly powders, which are unable to maintain the cylindrical shape obtained upon extrusion for any length of time" (page 5 of the Declaration).

The Declaration therefore serves to highlight the unpredictability associated with the Examiner's proposed modification. In the § 103 rejection set forth in the final Office

Action, the Examiner takes the position that it would have been obvious “to optimize the amounts” of the components. See, e.g., Office Action at 8. Because of the significant unpredictability in the properties of the compositions having components in different amounts, one of ordinary skill would not have a reasonable expectation of success in using a larger amount of pearlescent agent in the composition to achieve desired properties and arrive at the claimed invention. The Declaration provides objective evidence supporting this conclusion. Therefore, no prima facie case has been made.

Finally, in response to the Examiner’s statement that the results in the Declaration “are not of the same scope of the instant claims,” Applicants again reiterate that these results demonstrate the unpredictability of the modifications suggested by the Examiner. As such, these results showing unpredictability undermine the foundation of the Examiner rejection – that it would be obvious to optimize the amounts of the components – and Applicants respectfully request the withdrawal of the rejection over the ‘704, ‘862, and ‘345 patents.

EP ‘930 and JP ‘717

The Examiner relies on the disclosure of the ‘345 patent as a translation of EP ‘930. Office Action at 13.

As discussed above, no prima facie case of obviousness has been made with respect to the ‘345 patent. Accordingly, Applicants respectfully request that the rejection over EP ‘930 be withdrawn.

The Examiner asserts that JP ‘717 teaches a solid cosmetic composition comprising from 0.1 to 50% by weight of organopolysiloxane. See Office Action at 14. The Examiner admits that JP ‘717 “fails to teach the claimed particulate phase B in the

composition and the additional components . . . of the instant claims” and relies on EP ‘930 to remedy the deficiencies of JP ‘717. *Id.* at 15. The Examiner argues that it would have been obvious to include the cosmetic additives of EP ‘930 in the composition of JP ‘717 because both references are directed to the same type of cosmetic compositions. *See id.*

JP ‘717 is completely silent with respect to the use of pearlescent agents, let alone teaching an amount ranging from 10% to 50% by weight, relative to the total weight of the composition. Further, it fails to provide any guidance with respect to the desirability of using pearlescent agents in an amount in the claimed range, and fails to provide a reasonable expectation of success in arriving at the claimed invention.

As discussed above, EP ‘930 (the ‘345 patent) fails to rectify the deficiency of JP ‘717 as it does not teach or suggest the claimed range and fails to provide a reason for a person of ordinary skill in the art to go beyond its disclosure to arrive at the claimed range. Moreover, EP ‘930 (the ‘345 patent) fails to provide a reasonable expectation of success for a person of ordinary skill to arrive at the presently claimed invention. Therefore, JP ‘717 in view of EP ‘930 does not establishing a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection over JP ‘717 in view of EP ‘930 be withdrawn.

### **III. Obviousness-Type Double Patenting Rejection**

Claims 1-5, 8-51 and 57-63 remain rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-63 of the ‘345 patent. *See* Final Office Action at 2.

The Examiner concedes that the '345 patent does not teach the exact ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the '345 patent to achieve the present invention. See *id.* Applicants respectfully traverse the rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '345 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the '345 patent. See MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that pending claims 1-4, 8-20, 22, 25-51, and 57-63 of this application are not obvious over claims 1-63 of the '345 patent.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently claimed invention is an obvious variation of the invention claimed in the '345 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the '345 patent teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1.

Independent claims 1, 59, 62, and 63, as amended, recite "wherein said at least one particulate phase B comprises at least one pearlescent agent, present in an amount

ranging from 10% to 50% by weight, relative to the total weight of the composition.” As discussed above in the section regarding the 35 U.S.C. § 103 rejections, the Office has failed to show that the presently claimed invention is an obvious variation of the invention claimed in the ‘345 patent. Therefore, the Office has failed to satisfy those requirements in this rejection.

Accordingly, this rejection is improper and Applicants respectfully request that the rejection be withdrawn.

#### **IV. Conclusion**

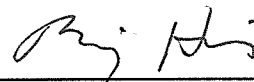
In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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